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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,325	03/31/2004	Nigel King	021756-087600US	9127
51206 7590 11/12/2009 TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER MANSFIELD, THOMAS L				
ART UNIT		PAPER NUMBER		
3624				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/816,325

Applicant(s)

KING, NIGEL

Examiner

THOMAS MANSFIELD

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Final Office action is in reply to the applicant amendment filed on 30 June 2009.
2. Claims 1-10 have been amended.
3. Claims 1-10 are currently pending and have been examined.

Response to Amendment

4. In the previous office action, Claims 1-15 were subject to election/restriction. Acknowledgement was made that Claims 1-10 were elected without traverse and Claims 11-15 were withdrawn from further consideration without traverse. However, it is now noted that in response to the previous office action, Applicant has cancelled Claims 11-15.
5. In the previous office action, Claims 1-8 were rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant's amendments to Claims 1-8 now recite statutory subject matter and the rejection is **withdrawn**.

Response to Arguments

6. Applicant's arguments filed 30 June 2009 have been fully considered but they are not persuasive.
7. Applicant submits that Srinivasan et al. (Srinivasan) (U.S. 6,895,382) in view of Rush et al. (Rush) (U.S. 6,119,102) does not teach or suggest in amended Claim 1: (1) the workflow, steps of the workflow and the interaction of the workflow participants in amended claim 1 [see Remarks page 11].
8. With regard to argument (1), the Examiner respectfully disagrees. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. In response to Applicant's amendments to Claim 1, see the below rejection for further detail.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan et al. (Srinivasan) (U.S. 6,895,382) in view of Rush et al. (Rush) (U.S. 6,119,102).

With regard to Claims 1, 9, and 10, Srinivasan teaches a *computer-implemented method, system, and computer-readable medium for deciding whether to make an item* (application (or suite of applications), business process) *in-house* (in-house) *or to buy the item from outside suppliers* (to assess a business process or application to determine whether it can be developed or supported (i.e., outsourced) from a remote location), local, remote), *comprising: launching a workflow* (waterfall method, stages in the order of taking an inventory of processes and applications to finalize suitable candidates) *from a first user interface associated with a computer for arriving at the make or buy decision* (see at least column 7, line 1 through column 8, line 46); *displaying information on a second interface associated with a computer, the information indicative of the make or buy decision* (see at least FIG.'s 3-16 and Tables 1-3); wherein the workflow includes:

- *forwarding, using the at least one computer in a set of one or more computers, information that enables one or more workflow participants in a marketing department of an enterprise* (staff of the organization system interface) *to generate a market specification* (requirements, program specifications, Selection criteria) *describing the item to be made in-house or purchased from outside suppliers* (see at least column 2, lines 10-58 and column 8, lines 17-46 and Table 1);
- *receiving, at at least one computer in the set of one or more computers, the market specification from the one or more workflow participants in the marketing department* (see at least column 2, line 10 through column 6, line 48 and column 8, lines 17-46 and Table 1);

- *receiving, at at least one computer in the set of one or more computers, information estimating a market volume (deliverables) for the item described in the market specification from the one or more workflow participants in the marketing department (see at least column 2, line 10 through column 6, line 48 and column 8, lines 17-46 and Table 1);*
- *forwarding, using the at least one computer in a set of one or more computers, information that enables one or more workflow participants in a planning department of the enterprise to derive a materials requirement plan (high level system design, low level system design) from the generated market specification and the estimated market volume (see at least column 2, lines 10-59);*
- *receiving, at at least one computer in the set of computers, the material equipment plan (system design, type of hardware used) from the one or more workflow participants in the planning department (see at least column 2, line 10 through column 6, line 48 and column 8, lines 17-46 and Table 1);*
- *receiving, at at least one computer in the set of computers, information estimating a unit cost (Rates) for producing the item in-house from one or more workflow participants in the costing department of the enterprise (in-house Rate) (see at least column 2, lines 31-59 and column 26, lines 18-67 and 1.4 STAFF TRANSITION MATRIX);*
- *forwarding, using at least one computer in the set of computers, information that enables one or more workflow participants in the costing department to determine a unit opportunity cost from the established purchase price to buy the item and the estimated in-house unit cost (cost/benefit analysis, financial feasibility) (see at least column 2, lines 31-59 and column 26, lines 18-67 and 1.4 STAFF TRANSITION MATRIX);*
- *forwarding, using at least one computer in the set of computers, information that enables the one or more workflow participants in the costing department to extend the unit opportunity cost (inflation figure, uplifts, adders and overheads) by the quantity of the item specified in the material requirement plan to determine a gross opportunity cost (see at least column 26, line 18 through column 28, line 9 and 1.4 STAFF TRANSITION MATRIX).*

- *receiving, at at least one computer in the set of computers, information estimating a cost of acquiring a production capacity to produce the item in-house from the one or more workflow participants in a costing department of the enterprise (see at least column 25, line 1 through column 28, line 9 and 1.4 STAFF TRANSITION MATRIX);*
- *receiving, at at least one computer in the set of computers, information determining to make the item in-house from the one or more workflow participants in a costing department of the enterprise if a net present value (Nett Rates) of the gross opportunity cost is more than the estimate cost of acquiring the production capacity (financial feasibility of the proposed outsourcing initiative [sic]), otherwise receiving, at the at least one computer in the set of computers, information determining to buy the item from at least one of the outside suppliers (see at least column 25, line 1 through column 28, line 9 and 1.4 STAFF TRANSITION MATRIX).*

Srinivasan does not specifically teach forwarding/receiving the engineering specification, using the at least one computer in the set of one or more computers, information that enables one or more workflow participants in an engineering department of an enterprise to develop an engineering specification defining the item from the generated market specification from the one or more workflow participants in the engineering department. Rush teaches forwarding/receiving the engineering specification, using the at least one computer in a set of one or more computers, information that enables one or more workflow participants in a engineering department of an enterprise to develop an engineering specification defining the item from the generated market specification from the one or more workflow participants in the engineering department (item master extension file) in analogous art of manufacturing supply and demand for the purposes of, "to store most of the data relative to items, or parts" (see at least column 4, lines 42-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the manufacturing supply and demand method as taught by Rush with the method for implementing an off shore/off site activity of Srinivasan. One of ordinary skill in the art would have been motivated to do so for the benefit of improving MRP regeneration times (Rush, column 4, lines 43-67).

Srinivasan does not specifically teach *receiving, at at least one computer in the set of computers, information establishing a purchase price to buy the item from the one or more workflow participants in a purchasing department of the enterprise*. Rush teaches *receiving, at at least one computer in the set of computers, information establishing a purchase price* (price information (for parts which are purchased)) *to buy the item from the one or more workflow participants in a purchasing department of the enterprise* in analogous art of manufacturing supply and demand for the purposes of, "to store most of the data relative to items, or parts" (see at least column 4, lines 42-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the manufacturing supply and demand method as taught by Rush with the method for implementing an off shore/off site activity of Srinivasan. One of ordinary skill in the art would have been motivated to do so for the benefit of improving MRP regeneration times (Rush, column 4, lines 43-67).

With regard to Claim 2, Srinivasan teaches *wherein receiving, at the at least one computer in the set of computers, the materials requirement plan* (Milestones in a Conversion Life Cycle, Tables 3A and 3B) *from the one or more workflow participants in the planning department includes a bill of materials detailing components and sub-components* (various components) *needed to build the item, current inventory* (project inventory) *of the components and sub-components* (I:O = in-house: Outsourced) *and an amount of the components and sub-components that must be purchased* (I:O = in-house: Outsourced), *phased over time* (Per Phase) (see at least column 5, lines 3-45, column 7, lines 1-7, and column 13, line 61 through column 18, line 48).

With regard to Claim 3, Srinivasan does not specifically teach *wherein receiving, at the at least one computer in the set of computers, the engineering specification from the one or more workflow participants in the engineering department includes a technical description of the item and of any tooling, plant layout and materials needed to produce the item*. Rush teaches *wherein receiving, at the at least one computer in the set of computers, the engineering specification from the one or more workflow participants in the engineering department includes a technical description of the item and of any tooling* (tooling) (see at least column 8, lines 4-22), *plant layout* (setup, production, move, queue) *and materials* (Gross Requirements) *needed to produce the item* in analogous art of manufacturing supply and demand for the purposes of, "items on a sales order or job order" (see at least column 3, line 26 through column 4, line 42).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the manufacturing supply and demand method as taught by Rush with the method for implementing an off shore/off site activity of Srinivasan. One of ordinary skill in the art would have been motivated to do so for the benefit of uniquely identifying items such as non-MRP item data sets (Rush, column 3, lines 26-52).

With regard to Claim 4, Srinivasan teaches:

- *receiving information indicating whether an item matching or substantially matching requirements defined in the engineering specification (Selection criteria, Selection Parameters) is available (availability of resources or cost) from the outside suppliers (see at least column 8, line 39 through column 12, line 65 and Tables 1 and 2).*
- *receiving information placing the item defined in the engineering specification up for bid (Special Bids, Bid Edits) by the external suppliers (see at least column 35, lines 3-15).*

With regard to Claim 5, Srinivasan teaches *receiving, at at least one computer in the set of computers, information indicative of a financial justification calculation (financial feasibility), the financial justification calculation being a difference between the net present value of the gross opportunity costs and the estimated cost of acquiring the production capacity to produce the item in-house (see at least column 25, line 1 through column 28, line 9 and 1.4 STAFF TRANSITION MATRIX).*

With regard to Claim 6, Srinivasan teaches *wherein based on a determination to make the item in-house, the workflow further including receiving at at least one computer in the set of one or more computers, information scoring the gross opportunity cost according to how aligned making the item in-house is with non-financial criteria (Skills Matrix) (see at least column 25, line 1 through column 28, line 9 and 1.4 STAFF TRANSITION MATRIX).*

With regard to Claim 7, Srinivasan teaches wherein *receiving at the at least one computer in the set of computers, information estimating the unit cost for producing the item in-house includes at least one of a cost of a plant and equipment* (plant machinery or equipment) *needed to manufacture the item* (Real time systems), a factory layout cost, and a building cost (see at least column 12, line 31 through column 13, line 12).

With regard to Claim 8, Srinivasan teaches wherein the *non-financial criteria include process technology advantage* (cutting edge technology), *tooling technology advantage* (cutting edge tools), *volume and intellectual property protection* (intellectual property concerns) (see at least column 11, line 29 through column 13, line 12).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
- House et al. (U.S. 6,785,805) discloses a network-based configuration method for systems integration in test, measurement, and automation environments that includes decisions of whether to manufacture in-house or outsource manufacturing of products.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS MANSFIELD whose telephone number is (571)270-1904. The examiner can normally be reached on Monday-Thursday 8:30 am-6 pm, alt. Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on 571-272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. M./
Examiner, Art Unit 3624

7 November 2009
Thomas Mansfield

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 3624